Application No.: 10/724,330
Reply to final Office Action of: June 1, 2006

REMARKS

This amendment is responsive to the final Office Action dated June 1, 2006. Claims 17-48 are pending. By submitting this amendment and RCE, Applicant requests continued consideration and allowance of this application. Specifically, claims 17 and 33 are amended.

Rejections Under 112

In paragraph 2 of the final office action, claims 17-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner indicates that Claim 17 recites:

identifying select data including dynamic video and text data
relating to the vendor and then providing the dynamic video and
text data to said active buyer responsive to said commercial
transaction data. (lines 12-15).

However, the Examiner asserts that lines 6-7 of claim 17, already recite a step in which dynamic video data from the vendor is provided to the buyer. Applicant's specification fails to provide support for an additional step of providing identified dynamic video and text to the active buyer (lines 12- 15) after having already provided dynamic video data to a buyer (lines 6-7). Applicant has amended claim 17 by changing "and" to --for—thereby making it clear that the claimed method receives and stores dynamic video data for providing it to the buyer when selected by the commercial transaction communication control system.

Claim 17 also recites "selectively routing the active buyer to another distinct vendor based on the request data" (lines 15-16). However, the Examiner asserts that there is no description of such selective routing to another vendor after providing identified video and text to the active buyer. Claim 17 is amended to clarify that routing to another vendor is in the event a first vendor does not fulfill a request. Claim 33 similarly recites the above subject matter and is amended in a similar manner.

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Application No.: 10/724,330
Reply to final Office Action of: June 1, 2006

The Examiner is respectfully requested to withdraw the rejection.

Rejections Under 103

Governing Criteria

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a prima facie case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)) Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan,

Page 9 of 16

Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

confronted with the <u>same</u> problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Examiner is urged to reconsider the rejections under 35 U.S.C. Section 103 based on the case law cited above.

Discussion of the Rejections

     In paragraph 4 of the office action, the Examiner rejected claims 17-29, 33-45 under 35 U.S.C. 103(a) as unpatentable over Smith (US 5,450,123) in view of Grady et al. (US 5,712,906, hereinafter "Grady").

     The Examiner asserts that:

         Smith discloses a method for selectively accomplishing electronic communication between members of plural groups, including at least one potential buyer (caller at video station 1) and at least one vendor (agent at station 2), at remote sites (stations are coupled via PSTN 3), via commercial transaction communication control system (see Figures 1 and 2), comprising the steps of:
         accessing said system (system can be accessed via computer 5; Figure 1);
         receiving and storing dynamic video data from a vendor (vendor-supplied video images are stored in a video source and database 6, and a selected video image is provided to the caller; col. 2, lines 65-68; col. 5, line 1 - col. 6, line 14);
         storing data associated with an active buyer including buyer identification data and commercial transaction data (service parameters stored in processor 9, 11 or 22 include a caller's telephone number (ANI) and account type; col. 4, lines 2-7; col. 5, lines 1-5, 19-22); and
         selectively processing the commercial transaction data by first identifying select data and then providing the dynamic video and text to said active buyer (based on the caller's account type, an appropriate video message from video source 6 is provided to the caller; col. 5, lines 17-37; a video message can include text, col. 6, lines 45-49).
         Smith differs from claims 17 and 33 in that it does not specify text communications between the vendor and buyer. However, Grady, from the same field of endeavor, teaches the desirability of providing text communications (email) between terminals (col. 11, lines 46-47) in addition to video and multimedia communication. It would have been obvious to an artisan of
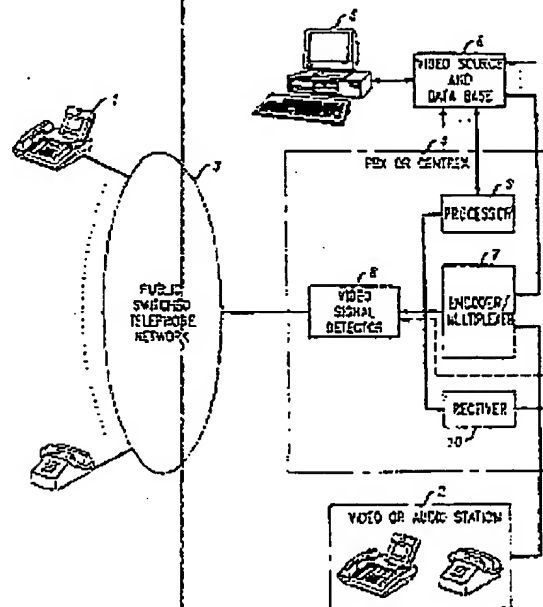
Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

ordinary skill to provide for text communications, as taught by
Grady, between the caller and agent stations of Smith in order to
provide an additional means of communication.

The Examiner acknowledges that Smith differs from claims 17 and 33 in that it does not

specify text communications between the vendor and the buyer. However, that void, the

Examiner believes is easily filed by the teaching in Grady, which the Examiner asserts is from

the same field of endeavor.

Respectfully, Smith is distinct from the claimed invention for other reasons as well.

Smith teaches a system (see drawing below), which is directed to an arrangement for supplying

audio and video signals from separate sources to a video telecommunications station.

This invention relates to an arrangement for supplying audio and
video signals from separate sources to a video telecommunication
station. In one embodiment, the audio is supplied, for example, by
a stock broker or agent, while the video is supplied by a separate
source controlled by the agent. Advantageously, pre-planned video
from a common source, or video from a separate camera, can be
supplied to a caller along with the audio message from the agent.

Page 11 of 16

Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

Smith does not teach a commercial transaction communication control system in the context of the claims. Grady teaches a communications system supporting shared multimedia sessions. Note that Grady is directed to:

> [a] public switched telephone network for providing information from a multimedia information server to any one of a plurality of subscriber premises, comprises a central office receiving multimedia information signals from a multimedia information server and orders from a prescribed subscriber. The central office includes a gateway system for conveying routing data in response to subscriber orders and a switch for routing multimedia signals from the server to the prescribed subscriber in accordance with the routing data. An interface at the central office transmits and receives audio telephone service signals, subscriber control signals and digital multimedia information signals on first, second and third signal channels. Each subscriber premises includes an interface for transmitting and receiving audio telephone service signals, subscriber control signals and digital multimedia information signals on the three signal channels. A plurality of subscriber local loops interconnect each subscriber interface and the central office interface. Multimedia information is collected from information providers and stored at media servers that provide a library of data and control sessions. Software modules at the media servers and resident terminals enable interactive multimedia session building, sharing of databases and joint authoring of multimedia presentations.

Neither reference, alone, or in combination, teach the claimed steps of storing data associated with an active buyer, in a memory associated with the commercial transaction communication control system including buyer identification data and commercial transaction data that includes request data entered by the active buyer and selectively processing the commercial transaction data by first identifying select data including dynamic video and text data relating to the vendor and then providing the dynamic video and text to the active buyer responsive to said commercial transaction data and in some instances selectively routing the active buyer to another distinct vendor based on the request data in the event a first vendor does not fulfill a request.

Page 13 of 16

Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

Regarding claims 18-19, 22-24, the Examiner asserts that Smith provides for a camera at each videophone station to provide direct, point-to-point video communication (col. 4, lines 24-28).

> If not, the call is completed normally without providing special service (action block 312). (Of course, if both parties have video stations they may communicate over these video stations using the video service provided by those stations which is a direct, point-to-point video communication).

Regarding claims 20, 25, the Examiner asserts that in Smith, the video image can include a dynamic graph associated with the vendor's company (col. 6, lines 44-49).

> FIG. 7 illustrates a request for a video signal while a call is in progress. For example, the stock broker and customer may have been discussing a particular company and the stock broker wants to display to the caller a dynamic graph illustrating earnings over the last ten years, and growth and shifts in industry outlook.

With respect to claims 18-19, 22-24 and 20, 25, they depend ultimately on claim 17 and incorporate the limitations of claim 17, which are distinguished above. Accordingly, these claims are also distinct at least for the reasons by which claim 17 is distinct.

Regarding claims 21, 33-41, Grady teaches the multi-media presentation as including still images and plain text (col. 1, lines 35-38; col. 5, lines 8-9).

> The video image is limited to the input source at the origin of the audio, e.g., within camera range, and does not allow for a video source from another origin.

> the calling and called parties are connected. Once the calling and called parties are connected, the called party determines by service code or real-time input...

Claim 21 is dependent on claim 17 and is distinct at least for the reasons by which claim 17 is distinct. Claims 33-41 recite limitations not met by Grady. Grady does not disclose the claimed steps of storing data associated with an active buyer, in a memory associated with the commercial transaction communication control system including buyer identification data and commercial transaction data that includes request data entered by the active buyer and selectively

Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

processing the commercial transaction data by first identifying select data including dynamic video and text data relating to the vendor and then providing the dynamic video and text to the active buyer responsive to said commercial transaction data and in some instances selectively routing the active buyer to another distinct vendor based on the request data in the event a first vendor does not fulfill a request. Claims 34-41 depend on claim 33 and are distinct at least for the reasons by which claim 33 is distinct.

Regarding claims 26, 42, Smith provides for real-time audio communication via videophone stations (col. 3, lines 5-19).

> If station 2 is a video station (and it need not be in order to get many of the benefits of applicant's invention), video station 2 receives either the video and audio signal generated by video station 1, or the audio signal generated by video station 1, and a video signal from video source 6. PBX or Centrex 4 also contains a video signal detector 8 in order to allow the service implemented by applicant's invention to be invoked if the caller is calling from a video station. This video signal detector may be associated with encoder 7, may be a separate circuit to detect the special characteristics of an audio/video signal, or may be responsive to a common channel signaling message (not shown) for informing the PBX or Centrex 4 that the call is a video/audio call.

Claims 26 and 42 depend on claim 17 and 33, respectively, each of which is distinct. Accordingly, claims 26 and 42 are also distinct.

Regarding claims 27-29, 43-45, Smith provides for the caller entering a service code or real-time input to select a desired video source signal (col. 4, lines 45-48, 62-66; col. 5, lines 7-22).

> The calling party answer step may be temporarily deferred to allow the caller to access the video source under his own control or to receive a preliminary video or audio/video signal prior to requesting a connection to an agent. In some cases, the connection to an agent may not be necessary.

> In the case of audio/video, a video or video/audio logo or other informational video or video/audio signal can also be supplied under the control of the subscriber facilities using this invention.

Page 14 of 16

Application No.:   10/724,330
Reply to final Office Action of: . June 1, 2006

Once the calling and called parties are connected, the called party determines by service code or real-time input, (for example, using a keypad entry) whether a prerecorded video is to be sent to the calling party (test 407). If not, then normal call handling (action block 314 of FIG. 3) continues. If a prerecorded video message is to be sent to the calling party either because the called party has so specified or because of a positive result of test 403 resulting from a delay in establishing a connection to the called party, then service parameters stored in processor 9 are used to determine the source of the video signal (action block 409). The service parameters, might, for example, refer to the type of the account of the caller, so that an appropriate video announcement can be returned.

Claims 27-29, 43-45 depend ultimately on claims 17 and 33, respectively, and are distinct at least for the reasons by which claims 17 and 33 are distinct.

In paragraph 5, claims 30-32 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Grady, as applied to claims 27 and 43 above, and further in view of Brown et al. (US 4,972,318, hereinafter "Brown"). The Examiner asserts that the combination of Smith and Grady differs from claims 30 and 46 in that it does not teach the use of EDI data. However, since Smith relates to a sales and ordering system (Smith, col. 2, lines 58-68), and Brown teaches the well known use of EDI to communicate transactional information (col. 1, lines 33-48), it would have been obvious to an artisan of ordinary skill to incorporate such use of EDI, as taught by Brown, within the combination of Smith and Grady in order to allow for product ordering using EDI data, as used by vendors and suppliers. Regarding claims 31-32 and 47-48, Brown teaches the order system being combined with inventory control (Figures 2 and 6(d)) and provides notification to the buyer when the desired product is out-of-stock (col. 9, lines 39-42).

Applicant respectfully submits that the Examiner is combining the references without any suggestion in Smith or Grady that invites a further combination with Brown. Neither Smith nor Grady disclose the claimed steps as urged above in the context of a commercial transaction communication control system. Moreover, claims 30 and 32 depend ultimately on claim 17 and claims 46-48 depend ultimately on claim 33 are distinct at least for the reasons by which the independent claims are distinct.

Application No.:   10/724,330
Reply to final Office Action of: June 1, 2006

   The Examiner is respectfully requested to reconsider the claims based on the legal

reasoning and case law cited above as well as the amendments to the claims.

                               Respectfully submitted,

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